

Application No. 10/601,828

Amendment dated

Reply to Office Action of December 24, 2009

Docket No.: 216683-114025

REMARKS

Claims 1, 17-19, 33-49 and 51-67 are pending with claims 2-16, 20-32 and 50 being previously cancelled while claims 33-35, 37-39, 41-42 and 51-67 have been previously withdrawn from consideration. In this paper, no claims have been amended or cancelled. Applicant has added new claims 68-76, each being dependent claims. Note that claims 70, 73 and 76 are in dependent form and include the alleged intended-use limitations of independent claims 1, 40 and 47 but cast in means-plus-function form. Accordingly, claims 1, 17-19, 33-49 and 51-76 will remain pending upon entry of this paper.

Examiner Interview Summary

Applicants thank the Examiner for the telephonic interview of June 24, 2010 during which the claims were discussed. Applicants specifically discussed Sarka reference with the Examiner. Participants in the telephonic interview included Examiner Dexter and Applicants' representatives Daniel J. Henry and Timothy M. Bogel. No exhibits were shown and no demonstration conducted.

I. Teaching of U.S. 3,863,550 to Sarka et al.

As far back of the first Non-Final Office Action dated December 14, 2004, the Office has relied on U.S. 3,863,550 to Sarka et al. (hereinafter, "Sarka") in order to reject the claimed invention. In view of Sarka's written description at col. 3, line 50 through col. 4, line 14, Applicant notes that Sarka's originally-filed drawings at Figures 8 and 10-11 contain several inconsistencies that may easily result in one not being able to clearly understand Sarka's explicitly-described disclosure when looking only to Sarka's Figures.

The Examiner's argument fails to meet the burden of 35 U.S.C. 103 at least because 1) Sarka does not teach an adhesive and 2) Sarka teaches directly away from using an adhesive by requiring a mold release agent (the opposite of an adhesive). Accordingly, in an effort to clearly define what is *explicitly taught* in Sarka's written description, Applicant sets forth the following modified views of Sarka's originally-filed drawings at Figures 10-11.

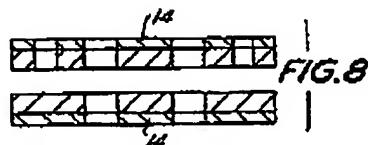
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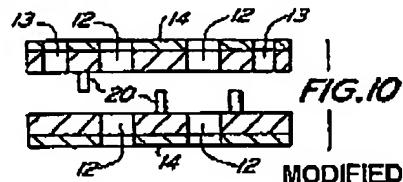
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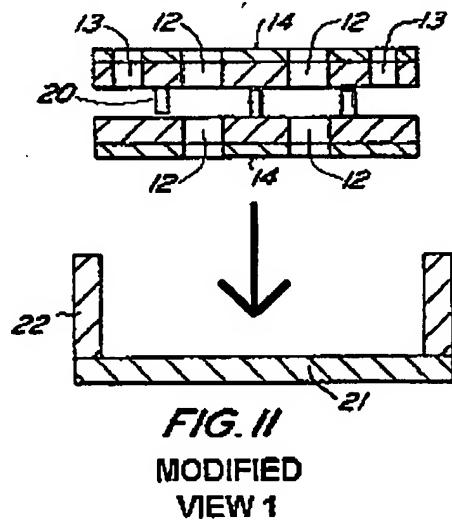
Firstly, at Figure 8 (see also col. 3, lines 50-55), Sarka's plates (1, 2) are coated with a mold release film (14).



Then, at Figure 10, which has been MODIFIED to include the mold release film (14) of Figure 8 (see also col. 3, lines 65-67), posts (20) are welded to the plates (1, 2).



Then, the plates (1, 2) with the posts (20) and mold release film (14) are inserted into a molding fixture (21, 22) (see MODIFIED VIEW 1 of Figure 11 and col. 4, lines 2-4).



Then, the steel rules (15, 16) are coated with mold release (14) and subsequently inserted into slots (12) formed in the plates (1, 2) (see MODIFIED VIEW 2 of Figure 11 and col. 4, lines 4-6).

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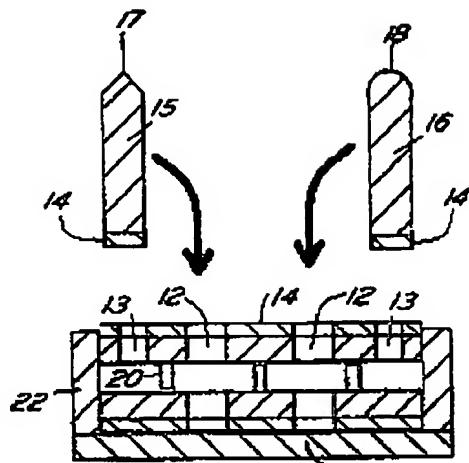


FIG. II

MODIFIED
VIEW 2

Once the steel rules (15, 16) are located within the slots (12), a plastic filler material (23) is injected through holes (13) formed in the plate (1) in order to fill a space between the plates (1, 2) and the posts (20) (see MODIFIED VIEW 3 of Figure 11 and col. 4, lines 6-8).

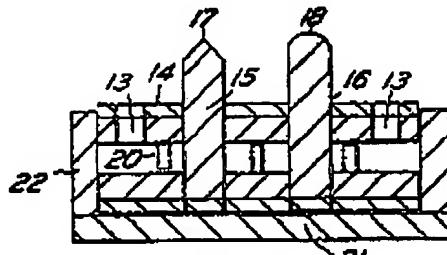


FIG. II

MODIFIED
VIEW 3

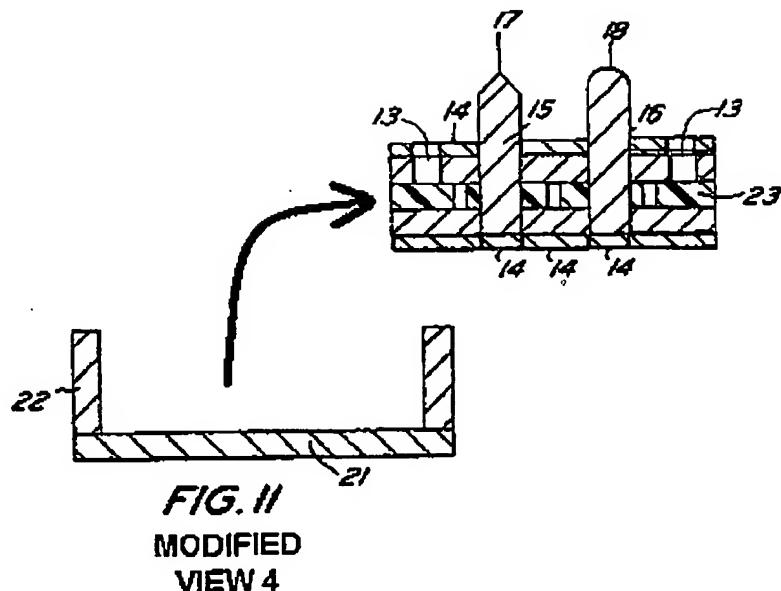
Once the plastic filler material (23) has cured, the assembled die plate (25) containing the steel rules (15, 16) is removed from the molding frame (21, 22) (see MODIFIED VIEW 4 of Figure 11 and col. 4, lines 8-12).

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**II. Rejections Under 35 USC § 103**

The Office has rejected the claims of the present invention as follows in the December 24, 2009 Office Action:

3. Claims 1, 17-19, 40 and 43-49 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Sarka et al., pn 3,863,550 in view of at least one of Phillips et al., pn 2,885,933 (hereafter Phillips '933), Phillips et al., pn 2,993,421 and Kang, pn 4,12,827 or, in the alternative, under 35 U.S.C. 103(a) as obvious over the combination of Sarka et al., pn 3,863,550 in view of at least one of Phillips et al., pn 2,885,933 (hereafter Phillips '933), Phillips et al., pn 2,993,421 and Kang, pn 4,12,827, and further in view of Beroz et al., pn 6,543,131.

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4. Claim 36 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Sarka et al., pn 3,863,550 in view of at least one of Phillips et al., pn 2,885,933 (hereafter Phillips '933), Phillips et al., pn 2,993,421 and Kang, pn 4,12,827 or, in the alternative, under 35 U.S.C. 103(a) as obvious over the combination of Sarka et al., pn 3,863,550 in view of at least one of Phillips et al., pn 2,885,933 (hereafter Phillips '933), Phillips et al., pn 2,993,421 and Kang, pn 4,12,827, and further in view of Beroz et al., pn 6,543,131, and further in view of Johnson, pn 6,658,978.

In view of the following remarks, the rejections are respectfully traversed.

A. Allegation That Sarka's Plastic Filler Gives Rise To "fixedly attaching"

At page 3 of the December 24, 2009 Office Action, the Office makes the following remark, which is reproduced below for convenience:

Further, Sarka meets the limitation of "fixedly attaching" in that when the plastic filler material is injected to fill the space and then cured as described (e.g., see col. 4, lines 2-13), the inner assembly will become stuck or held in place within the fixture and thus "fixedly attached to" the fixture, whereby a force will be necessary to remove the assembly from the fixture. Further, it is

Applicant traverses the remark in view of the following reasons.

Applicant submits that the term, "fixedly attaching" is applied to the claimed layer of adhesive for "*fixedly attaching said back surface of said at least one metal base portion to said covering.*" Conversely, it appears that Sarka's plastic filler material (23) merely attaches the plates (1, 2) to one another. Applicant submits that absolutely nowhere in Sarka's disclosure is any mention made of the plastic filler material (23) causing the "inner assembly becoming stuck or held in place within the fixture" or that "a force will be necessary to remove the assembly from the fixture" as alleged by the Office. In fact, Applicant hereby asserts that the Office is actually misstating or impermissibly adding-to Sarka's teachings when looking to the modified view of Sarka in Section I of this paper.

In view of the above remarks, Applicant submits that the plastic filler material (23) does not function in a "fixedly attaching" manner as the Office alleges. The remaining prior art references fail to make up for Sarka's deficiency. Withdrawal of the rejection of the claims is therefore requested.

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B. Allegation That It Would Be Obvious To Use Adhesive

At page 4 of the December 24, 2009 Office Action, the Office makes the following remark, which is reproduced below for convenience:

In the alternative, if it is argued that there is no explicit disclosure that the assembly will become fixedly attached fixture, it would have been obvious to one having ordinary skill in the art to use adhesive (e.g., two-sided adhesive tape or a mass of adhesive material) to affix the assembly, particularly plate 2, in the fixture to facilitate assembly of the die disclosed in Sarka. One having ordinary skill in the art would be

Applicant traverses the remark in view of the following reasons.

If one skilled in the art were to modify Sarka to include adhesive as proposed by the Office, Applicant submits that the modification would either: *change the principle of operation* or render Sarka *unsatisfactory for its intended purpose*; accordingly, **there would be no suggestion or motivation to make the proposed modification**. See MPEP §§2143.01, V., 2145, III., 2145X., D., which are reproduced below for convenience:

**2143.01 Suggestion or Motivation To
Modify the References [R-6]**

**V. THE PROPOSED MODIFICATION CAN-
NOT RENDER THE PRIOR ART UNSAT-
ISFACTORY FOR ITS INTENDED
PURPOSE**

If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)

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2145 Consideration of Applicant's Rebuttal Arguments [R-6]

III. ARGUING THAT PRIOR ART DEVICES ARE NOT PHYSICALLY COMBINABLE

However, the claimed combination cannot change the principle of operation of the primary reference or render the reference inoperable for its intended purpose. See MPEP § 2143.01.

X. ARGUING IMPROPER RATIONALES FOR COMBINING REFERENCES

D. References Teach Away from the Invention or Render Prior Art Unsatisfactory for Intended Purpose

In addition to the material below, see MPEP § 2141.02 (prior art must be considered in its entirety, including disclosures that teach away from the claims) and MPEP § 2143.01 (proposed modification cannot render the prior art unsatisfactory for its intended purpose or change the principle of operation of a reference).

In view of the above remarks, there would be no suggestion or motivation to utilize adhesive in Sarka's device as proposed by the Office; such a use of adhesive would change the principle of Sarka's operation or render Sarka unsatisfactory for its intended purpose. The remaining prior art references fail to make up for Sarka's deficiency. Withdrawal of the rejection of the claims is therefore requested.

C. "Response to Argument" Section

At page 6 of the December 24, 2009 Office Action, the Office makes the following remark, which is reproduced below for convenience:

In the first paragraph on page 10 of the subject response, applicant argues that Sarka removes the molding fixture after the molding manufacturing step. However, it is respectfully maintained that because the invention is directed to an apparatus/device and not a method, that the way in which Sarka is used is a matter of intended use. Since this intended use does not clearly imply any additional structure, it cannot be relied upon to patentably distinguish the claimed invention over the prior art.

Applicant traverses the remark in view of the following reasons.

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In Applicant's previous replies to the Office's previous rejections, Applicant has raised the issue that the claimed adhesive functions by fixedly attaching the base portion to the covering whereas Sarka utilizes a structurally divergent component (i.e., mold release film 14) for permissibly detaching a die plate (25) from a molding frame (21, 22). Referring to MPEP §2173.05(g), it is clearly stated that a functional limitation (e.g., "*operatively connected*," or, in the context of the present invention, "*fixedly attached*") must be evaluated and considered.

2173.05(g) Functional Limitations [R-3]

A functional limitation must be evaluated and considered, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used. A functional limitation is often used in association with an element, ingredient, or step of a process to define a particular capability or purpose that is served by the recited element, ingredient or step. >In *Innova/Pure Water Inc. v. Safari Water Filtration Sys. Inc.*, 381 F.3d 1111, 1117-20, 72 USPQ2d 1001, 1006-08 (Fed. Cir. 2004), the court noted that the claim term "operatively connected" is "a general descriptive claim term frequently used in patent drafting to reflect a functional relationship between claimed components," that is, the term "means the claimed components must be connected in a way to perform a designated function." "In the absence of modifiers, general descriptive terms are typically construed as having their full meaning." *Id.* at 1118, 72 USPQ2d at 1006. In the patent claim at issue, "subject to any clear and unmistakable disavowal of claim scope, the term 'operatively connected' takes the full breath of its ordinary meaning, i.e., 'said tube [is] operatively connected to said cap' when the tube and cap are arranged in a manner capable of performing the function of filtering." *Id.* at 1120, 72 USPQ2d at 1008.<

Thus, in view of the above support taken directly from MPEP §2173.05(g), it is abundantly clear that the Office's position in the "*Response to Arguments*" section is incorrect and the function of the adhesive layer can be used to patentably distinguish the claimed invention from Sarka. Accordingly, upon fully considering and appreciating the differences in function between the claimed "layer of adhesive" and Sarka's "mold release film," the rejection should be withdrawn.

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D. New Claims

New claims 68, 71 and 74 recite "adhesive fixedly attaches". This recitation is not intended use because it demonstrates the type of attachment in the apparatus. Moreover, as discussed above in detail, Sarka does not teach or suggest use of an adhesive. Thus, claims 68, 71 and 74 are allowable over the cited prior art.

New claims 69, 72 and 75 recite "the layer of adhesive permanently fixedly attaches". The word "permanently" was added as discussed in the Examiner Interview. This recitation is not intended use because it demonstrates the type of attachment in the apparatus. Moreover, as discussed above in detail, Sarka does not teach or suggest use of an adhesive. Thus, claims 69, 72 and 75 are allowable over the cited prior art.

Support can be found in the specification wherein:

[0037] The die cutting apparatus 10 also includes a housing 62 for receiving and holding the base plate 52 therein. The housing 62 is essentially a plastic cover that extends along the bottom surface 64 of the base plate 52 and around the perimeter 66 on all sides thereof. The housing 62 is held to the base plate 52 with a layer 68 of adhesive. (Emphasis added).

New claims 70, 73 and 76 recite "means for translating a pressing force". This recitation includes the alleged intended-use limitations of independent claims 1, 40 and 47 but cast in means-plus-function form.

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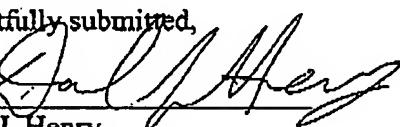
Conclusion

In view of the above, Applicant believes the pending application is in condition for allowance.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 50-3145, under Order No. 216683-114025 from which the undersigned is authorized to draw.

Dated: June 24, 2010

Respectfully submitted,

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